REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-21 are pending in the present patent application. Claims 1, 15, and 16 are independent. Claims 2-14 and 17-21 depend, either directly or indirectly, from claims 1 and 16.

Drawings

Applicant respectfully requests the Examiner acknowledge the formal drawings filed on June 29, 2001, and indicate whether they are acceptable.

Rejections under 35 U.S.C. §103

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over online publication www.entrust.com/news/files/5312.htm (hereinafter "Entrust") in view of "Microsoft Windows NT Server" (hereinafter "NTS") and "NT File System Security and Auditing" (hereinafter "FSSA") and "Windows 2000 Advanced Documentation" (hereinafter "Win2000"). For the reasons set forth below, this rejection is respectfully traversed.

As an initial matter, Applicant notes that various combinations of one or more of *four* references have been used in rejecting the claims of the present application. The purported reconstruction of the claimed invention by reliance on such a large number of references is not appropriate. It is abundantly clearly that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a "road map" for selecting and combining prior art disclosures is wholly improper. *See Interconnect Planning Corp. v. Feil,*

774 F.2d 1132 (Fed. Cir. 1985) (stating that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time"); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . . This court has previously stated that 'one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art").

Further, Applicant respectfully asserts there is no motivation to combine NTS and Entrust to purportedly render claims 1, 15, and 16, which (as amended) require access restrictions embedded on the smart card, to be obvious. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added). Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). In other words, there must be some objective reason to combine the teachings of the reasons. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

As discussed in the Office Action response dated May 31, 2005, NTS is directed towards the security architecture and features of the Windows NT Server Operating System.

NTS discloses that users may use a security token (e.g., a smart card) to log into a system, where upon validation of the security token, the system imposes access restrictions based on the authentication of the user. Thus, NTS discloses a situation where access restrictions associated with a user are embedded on the system, *not* within a smart card. Entrust discloses a smart card providing multiple security levels. Further, the Examiner asserts Entrust discloses access restrictions embedded within a smart card as recited in independent claims 1, 15, and 16. (See Office Action dated August 25, 2005 at pages 2 and 3). Thus, Entrust discloses a situation where access restrictions associated with a user are embedded within a smart card, *not* on the system. Accordingly, because NTS discloses access restrictions embedded on the system and not within a smart card while Entrust discloses access restrictions embedded within a smart card and not on the system, Applicant respects there is no motivation to combine the teachings of Entrust with the teachings of NTS.

Applicant acknowledges both NTS and Entrust address issues pertaining to security and smart cards generally, but as NTS and Entrust use smart cards in conflicting fashions (*i.e.,* access restrictions are embedded in different locations), Applicant asserts there is no motivation to combine NTS and Entrust. In fact, a complete study of NTS and Entrust confirms that, regardless of whether the teachings of NTS and Entrust can be combined, there is no suggestion or motivation set forth in either NTS or Entrust to combine the teachings of these references. Absent such a suggestion or motivation, the teachings of NTS and Entrust cannot be conveniently combined to render the claimed invention obvious.

In view of the above, independent claims 1, 15, and 16 are patentable over Entrust, NTS, FSSA, and Win2000. Claims 2-14 and 17-21 depend, either directly or indirectly, from
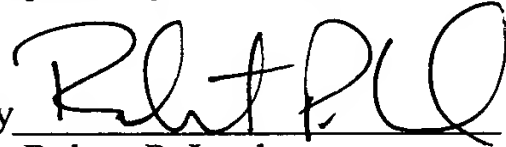
claims 1 and 16 and are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03226/558001).

Dated: October 21, 2005   Respectfully submitted,

By

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